



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|------------------------------------|-------------|----------------------|---------------------|------------------|
| 10/526,694 | 03/03/2005 | Hugo Camenzind | LA/1-22745/A/PCT | 5272 |
| 324 | 7590 | 09/17/2008 | EXAMINER | |
| JoAnn Villamizar | | | GOLOBOY, JAMES C | |
| Ciba Corporation/Patent Department | | | ART UNIT | |
| 540 White Plains Road | | | PAPER NUMBER | |
| P.O. Box 2005 | | | 1797 | |
| Tarrytown, NY 10591 | | | MAIL DATE | |
| | | | DELIVERY MODE | |
| | | | 09/17/2008 | |
| | | | PAPER | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/526,694

Applicant(s)

CAMENZIND ET AL.

Examiner

James Goloboy

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Applicant's arguments filed 6/6/08 fail to overcome the rejections set forth in the office action mailed 3/14/08, which are maintained below.

Claim Rejections - 35 USC § 103

2. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cox in view of Amende.

This rejection is adequately set forth in paragraph 3 of the office action mailed 3/14/08, which is incorporated here by reference.

3. Claims 1-6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kubo in view of Amende.

This rejection is adequately set forth in paragraph 4 of the office action mailed 3/14/08, which is incorporated here by reference.

Response to Arguments

4. Applicant's arguments filed 3/14/08 have been fully considered but they are not persuasive. Applicant argues that Amende is non-analogous art to Cox and Kubo, and therefore one of ordinary skill in the art would not have combined Amende with either of those references. Applicant asserts that Amende is in the textile art. However, a textile adjuvant is just one of the uses taught by Amende for the compound, which can also be used as an emulsifier. It is therefore the examiner's position that Amende can equally

be considered as part of the emulsifier art, and as Cox and Kubo do not place any specific limitations on the emulsifiers to be used in their compositions (Cox teaches some preferred emulsifiers, but explicitly states that any oil-in-water emulsifier is suitable), one of ordinary skill in the art would have looked to an emulsifier reference such as Amende, and would have had a reasonable expectation of success in using the emulsifier of Amende in the compositions of Cox or Kubo.

Applicant further argues that the claimed compositions give unexpectedly superior results, and points to the results given on page 21 of the specification in support of this argument. However, the results are not commensurate with the scope of the claims. The claimed composition can contain any amount of semi-amide, while the sample formulations all contain 0.1 mmol/kg of semi-amide.

JGG

/Glenn A Caldarola/

Acting SPE of Art Unit 1797